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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,574	07/12/2001	Paul G. Glucina	HR1.P03	4225

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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT	PAPER NUMBER
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1654

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/905,574
Filing Date: July 12, 2001
Appellant(s): GLUCINA ET AL.

Michelle Bos
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 24, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The application contains a single claim.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the Examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

A. On page 2, lines 18-19, the terms "Large" and "Vigorous" is vague and insufficient in describing the size and vigor of the tree. Additional information should be imported into the specification relative to characteristic and observed height and spread for the observed tree and amount of growth over a specified period of time. Correction is needed.

B. On page 3, line 1, the term "Medium" is vague and insufficient in describing the trunk of the observed tree. Applicant should disclose in the specification the observed trunk diameter (usually measured at a given height above soil level).

C. On page 3, line 5, the "Medium" does not describe the size of the observed tree's branches. Applicant should set forth a more detailed botanical description relative to branch size (diameter) and color.

D. On page 3, line 6, "Medium number" is vague and insufficient in describing the number of lenticels. Applicant should disclose the size, color, average number of lenticels the branch contains.

E. On page 3, line 11, Applicant should provide useful information regarding the shape (form) of the leaf by utilizing appropriate descriptive terms such as --oval-- or --elliptic--. The recitation "Pointed" is vague and insufficient. Correction is needed.

F. Applicant should disclose the leaf arrangement, vein color and venation pattern of the observed leaf.

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G. Applicant should disclose the petiole length and color of the observed leaf.

H. Applicant should disclose the number of glands of the observed leaf.

I. In the interest of providing as complete a botanical description of the observed plant as is reasonably possible Applicant should disclose the length, diameter, color and shape of the observed flower's bud. The terms "Medium to large," "Medium" and "Plump" are vague and insufficient in this regard. Clarification is needed.

J. Applicant should disclose the diameter of the flower. The recitation "Medium to large" is vague and insufficient in describing the flower diameter.

K. Applicant should disclose the margin, shape of the apex and base, texture, color (both surfaces) and number of the petals.

L. Applicant should set forth in the specification a description of the reproductive organs and should disclose such information and describe these structures (sizes, numbers, colors) in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

M. Applicant should disclose the size (diameter and circumference) of the observed fruit as "Medium" is vague and insufficient in this regard.

N. On page 5, line 20, Applicant states the density of pubescence as "Medium" which does not describe the density. Clarification is needed.

O. Applicant should clarify the use of the observed fruit i.e. dessert, canning, etc.

P. On page 6, line 14-16, it is unclear whether the observed fruit or the stone is used for local and export markets and has good storage capabilities. Clarification is needed.

Q. If additional information is available relative to plant/fruit disease resistance/susceptibility, such should be set forth in the specification.

R. Applicant should set forth in the specification information describing the kernel of the stone.

(11) Response to Argument

Appellant argues (brief, page 6) the botanical description and illustrations included in a plant patent application assist in identifying the plant claimed but have no impact on the scope of the claim. This argument, while correct, is not persuasive because Appellant has not explained

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why this fact relieves him of the statutory obligation to provide a complete description of the claimed plant.

Appellant argues (brief, pages 4-5) that an “enabling description” of the claimed plant is not required. This is correct. At no point in the prosecution of this application has such a requirement been made by the Examiner. However, 35 U.S.C. 162 and 37 CFR 1.163(a) require that the description of the claimed plant be as complete as reasonably possible. This is the standard that is being applied.

Appellant argues (brief, page 6) that there is no authority explaining why the plant characteristics he refuses to describe are critical to the written description. The Examiner is not required to cite any such authority.

Appellant argues (brief, page 6) that a “reasonably complete description” of a claimed plant variety is limited to identification of the “novel, distinguishing and non-variable characteristics of a new plant variety, and ... commercially relevant features of the variety.” This argument is not persuasive. 37 CFR 1.163(a) requires “as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents” (emphasis added). These are two distinct requirements. A limited disclosure which only describes the “distinguishing characteristics” of the claimed plant does not suffice. A disclosure of the plant which is “as full and complete... as possible” is also required.

Appellant argues (brief, page 7) that a highly detailed and exacting specification is not more useful in enforcing the rights of a patent holder. This argument is not directly relevant to the rejection. However, it is noted that Appellant’s focus on the patent holder’s rights overlooks the fact that the public is entitled to certain benefits in exchange for the grant of a U.S. patent. As stated by the Supreme Court, “the means adopted by Congress of promoting the progress of science and the arts is the limited grant of the patent monopoly in return for *the full disclosure of the patented invention* and its dedication to the public on the expiration of the patent (*Scott Paper Co. v. Marcalus Mfg. Co.*, 67 USPQ 193, 196, emphasis added). Appellant’s reluctance to provide a complete disclosure of the claimed invention is contrary to the spirit and purpose of the patent system.

Appellant argues (brief, pages 7-8) that many of the botanical characteristics of the claimed plant, for which the Examiner has required a detailed description, are variable. This

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argument is not persuasive. In biological systems, almost everything is variable. The Office recognizes that growing conditions influence plant morphology, yield and other characteristics. For this reason, Examiners typically request that the growing conditions and age of the observed plant be disclosed, to make the descriptions more meaningful. Describing the plant by using term such as "large" and "medium," without further elaboration, is vague and ambiguous. Furthermore, it is perfectly acceptable for morphological characteristics to be described as a range. Describing the leaf length as "8-10 cm" is more precise than "medium," for example, and is certainly more useful for comparing one plant with another. With regard to Appellant's continuing assertion that an "enabling description" is being required, the Examiner reiterates that no such requirement has been made.

Appellant argues (brief, page 9) that a detailed botanical description does not aid the USPTO in examining plant patent applications. This is not persuasive, and completely illogical, as a detailed botanical description **does** aid in distinguishing new plants from previously patented varieties as described above. As the list of issued plant patents grows, complete and precise descriptions are needed to aid in examining future plant patent applications. The distinguishing feature of the claimed plant appears to be the color of the fruit. The less detail that is provided in describing the rest of the plant, the more difficult it will be to distinguish any future fruited sports of the 'GL4/66' variety.

Appellant argues (brief, p. 8) that no matter how detailed the description of the plant, the Office cannot make a meaningful comparison with other plants. The Examiner recognizes the limitations inherent in comparing written descriptions rather than actual plants grown side-by-side under identical conditions. Nevertheless, it is clearly desirable to base a patentability determination on as much information as possible. The more information that is available to the Examiner, the greater the likelihood that the Examiner's determination will be correct.

Appellant argues (brief, pages 8-10) that, under the *Imazio* decision, a description of a plant cannot anticipate a description of a second plant variety. This is not persuasive because the *Imazio* decision concerned infringement, not patentability. Thus, the fact that the accused plant in the *Imazio* case was found not to infringe the patent at issue (by virtue of its "independent creation") does not mean that it was *patentably distinct* from the patented plant. Appellant's position that no plant can anticipate another is clearly incorrect, especially in view of MPEP

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1610, which provides a form paragraph for rejecting a claim under 35 U.S.C. 102 when the claimed plant is not patentably distinct from another variety known in the prior art.

[I]n order for the new variety to be distinct it must have characteristics clearly distinguishable from those of existing varieties.... The characteristics that may distinguish a new variety would include, among others, those of habit; immunity from disease; resistance to cold, drought, heat, wind, or soil conditions; color of flower, leaf, fruit, or stems; flavor; productivity, including ever-bearing qualities, in case of fruits; storage qualities; perfume; form; and cease of asexual reproduction. Within any one of the above or other classes of characteristics the differences which would suffice to make the variety a distinct variety, will necessarily be differences of degree. *Imazio Nursery Inc. v. Dania Greenhouses*, 36 USPQ2d 1673, 1677, quoting S. Rep. No. 315, 71st Cong., 2d Sess. 4 (1930).

Appellant argues that a vague description of the claimed plant does not result in a broad claim (page 10). Appellant misunderstands the Examiner's position. While the claim in this hypothetical example is still limited to a single plant, issuance of the patent would place into the patent files prior art which would be difficult to overcome. Appellant's ideal specification apparently would disclose a distinguishing characteristic ("characteristic X") of the claimed plant and very little meaningful information regarding the rest of the plant. Subsequent applicants who discovered other plants having characteristic X would find it difficult to distinguish their plant from the first, particularly when faced with a rejection under 35 U.S.C. 102(b). Thus the patenting of the first plant (with a vague description) would create an obstacle to the patenting of future varieties having the X trait, but differing in other characteristics.

Appellant argues (brief, pages 10) that the claimed plant has been distinguished from other varieties, citing *In re Greer*. This argument is not persuasive because *In re Greer* does not state that a reasonably complete description that distinguishes the new variety from its parents and from other known varieties is all that is needed to meet the requirements of 35 U.S.C. 162 and 37 CFR 1.163 that the specification must contain as full and complete a disclosure as possible of the plant.

Appellant does not understand that 37 CFR 1.163(a) requires "as full and complete a disclosure as possible" of 1) the plant and 2) the "distinguishing characteristics" of the plant. In *Greer*, the specification was deficient with regard to the second requirement, whereas the specification in the instant application is deficient with regard to the first requirement. Therefore the *Greer* decision has little bearing on the issue at hand.

Appellant argues (brief, page 12) that it is improper to require the specification to conform to terms selected by the Examiner. Applicant also argues the request by the Examiner for additional information is unsupported by specific reasons as to why such detail is necessary

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to a reasonably complete description. The Examiner has never required that the Appellant conform for the specification. This argument is discussed above sufficiently with regards to the botanical description required by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

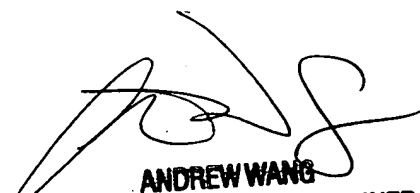
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May 16, 2005

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